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DATE MAILED: 10/11/2006

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,681	03/15/2004	Hirokazu Annoura	47259-0454	8653
55694 7.	590 10/11/2006		EXAMINER	
DRINKER BIDDLE & REATH (DC)			DESAI, RITA J	
1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209			ART UNIT	PAPER NUMBER
			1625	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
	10/799,681	ANNOURA ET AL.				
Office Action Summary	Examiner	Art Unit				
	Rita J. Desai	1625				
The MAILING DATE of this communication app	ears on the cover sheet with the c	orrespondence address				
Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
1)⊠ Responsive to communication(s) filed on <u>14 Ju</u>	dv 2006					
	action is non-final.					
· <u> </u>		esecution as to the marite is				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
closed in accordance with the practice under L	x parte Quayle, 1955 C.D. 11, 40	. · · · · · · · · · · · · · · · · · · ·				
Disposition of Claims						
4)⊠ Claim(s) <u>11,12,14-16 and 19</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>11,12,14-16 and 19</u> is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/or	r election requirement.					
Application Papers	•					
9) The specification is objected to by the Examiner.						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11)☐ The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.				
Priority under 35 U.S.C. § 119						
12)⊠ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No. 09043563.						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
·						
Attachment(s)						
1) Notice of References Cited (PTO-892)	A) Intention Summan	(PTO-413)				
1)						
3) Information Disclosure Statement(s) (PTO/SB/08)	5) Notice of Informal F	Patent Application				
Paper No(s)/Mail Date	6) Other:					

Application/Control Number: 10/799,681

Art Unit: 1625

## **DETAILED ACTION**

Applicants have elected Group II of the restriction.

Claims 11-19.

Claims 13 and 17 have been cancelled.

Pending claims are 11, 12, 14-16 and 19.

Double patenting rejection.

The rejection of the claims 11, 12, 14-16 and 19 still stands. Applicants argue that 10/331,508 is the parent case is not correct. US 6455549 case is issued from application # 09/043563.

The Bib data indicates the parent to be 10/196362, which is a divisional of 09/043563.

The parent claims were of different scope, however there is still overlapping subject matter.

The rejection still stands.

The rejection over US 6838470 still stands. This was originally application number 10/331,508 which is not the parent but has similar and obvious modifications of the subject matter.

While homology is considered to be present, even if true "homology" is not present, such does not defeat the prima facie case of obviousness raised by the art. In reDruey et al 50 CCPA 1538, 319 F. 2d 237, 138 USPQ 39 wherein Judge Worley, delivering the Courts's opinion stated:

"We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants that the term homologue is used by chemists at times in a broad sense, and at other times in a narrow or strict sense. The name used to designate the relationship between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound." 50 CCPA 1541.

## Conclusion

Claims 11, 12, 14-16 and 19 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rita J. Desai
Primary Examiner
Art Unit 1625

Q | 29/06

R.D. September 29, 2006